

REMARKS

Claims 1, 3-7, 10-13, 24, 26-30, 33-36, 47, 51, 56-59, 62, 63, 72-74, 77 and 78 are pending in the application.

Claims 1, 3-7, 10-13, 24, 26-30, 33-36, 47, 51, 56-59, 62, 63, 72-74, 77 and 78 have been rejected.

Claims 1, 10, 24, 33, 47, 51, 56, 62, 72 and 77 have been amended.

Unless otherwise specified in the below discussion, Applicants have amended the above-referenced claims in order to provide clarity or to correct informalities in the claims. Applicants submit that these amendments find support at least at pages 65-67 of the Application as filed. Applicants further submit that, unless discussed below, these amendments are not intended to narrow the scope of the claims. By these amendments, Applicants do not concede that the cited art is prior to any invention now or previously claimed. Applicants further reserve the right to pursue the original versions of the claims in the future, for example, in a continuing application.

Rejection of Claims Under 35 U.S.C. §103

Claims 1, 3-7, 10-13, 24, 26-30, 33-36, 47, 51, 56-59, 62-63, 72-74 and 77-78 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,449,598 issued to Green et al. ("Green") in view of U.S. Patent 6,490,619 issued to Byrne et al. ("Byrne") and further in view of U.S. Patent 5,845,255 issued to Mayaud ("Mayaud"). Applicants respectfully traverse this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in

the art at the time the invention was made. *See* 35 U.S.C. §103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Independent Claims 1, 24 and 47 each contain limitations of substantially the following form:

in response to said receiving the search request,
 determining the first user's organizational identifier, wherein
 the first user's organizational identifier corresponds to an
 organization with which the first user is associated, and
 performing a search of one or more databases for records
 corresponding to the search criteria, wherein
 said performing the search comprises
 selecting an organizational set of records that match the first
 user's organizational identifier from the one or more databases,
 and
 selecting a subset of records matching the search category from
 the organizational set of records.

See, e.g., Claim 1 (as amended). Applicants respectfully submit that none of the cited sections of Green, Byrne, nor Mayaud, alone or in combination, disclose all of these limitations of the independent claims.

The Office Action treats independent Claims 56 and 72 as having the same limitations as those of Claims 1 and 24, however Applicants submit that Claims 56 and 72 have different limitations that deserve separate treatment from that of Claims 1 and 24. Applicants therefore traverse the rejections as to those claims on that basis. But given that Claims 56 and 72 are treated in the same way by the Office Action as the other

independent claims, Applicants include Claims 56 and 72 in the discussion related to Claims 1, 24 and 47 to the extent that it is appropriate to do so.

Applicants respectfully submit that none of the cited sections of the references, alone or in combination, provide disclosure of the amended limitation: “in response to said receiving, determining the first user’s organizational identifier, wherein the first user’s organizational identifier corresponds to an organization with which the first user is associated.” The Office Action cites to several sections of Green as purported disclosure of the previous version of this limitation, but Applicants respectfully submit that each of the cited sections of Green fail to provide all of the elements of the “determining” limitation.

The Office Action initially cites to the Abstract of Green as purportedly providing disclosure of the “determining” limitation. In doing so, the Office Action emphasizes the Abstract’s disclosure of “administrative users” who can “set and change qualification parameters as to individual, group and/or institution-wide policy access and receive individual, group and/or institution-wide test results.” *See* Green, Abstract. Applicants respectfully submit that the Abstract provides no disclosure of determining of an “organizational identifier.” Further, Applicants submit that there is no indication that anything that occurs within the Abstract is performed “in response to said receiving [a search request],” as provided in the claims. In addition, Applicants submit that the mere indication that there is an “administrative user” does not indicate the use of an organizational identifier that corresponds to an organization to which the first user who is providing search criteria is associated. Thus, Applicants respectfully submit that Green’s Abstract fails to provide disclosure of the “determining” limitation.

The Office Action then cites to other portions of Green as providing purported disclosure of the “determining” limitation. The Office Action cites to Green 3:5-10, which provides:

A special feature enables each user to focus specifically on the policies for which he is responsible. Searching is set up to make it easy for a user to locate needed policy information, making it more likely that a user will actually refer to a policy for guidance.

Applicants submit that this quoted section of Green provides no disclosure of a first user’s organizational identifier or determining such an organizational identifier in response to receiving a search request that includes search criteria from that user. This cited section merely provides broad and vague description of some kind of “special feature” of the disclosed system. Further, the Office Action makes no connection between the above-quoted section of Green and the emphasized “administrative users” set forth by the Office Action with regard to the Abstract.

The Office Action then makes reference to Green 3:23-28, which provides:

Institution administrators can track who has reviewed a document, who has taken a test on the contents of the policy and the test results. Reports can be generated to demonstrate who has viewed and/or tested the policies by location, department, date, range, employee status and other parameters which are customizable as required.

Again, Applicants submit that this section provides no disclosure of determining a user’s organizational identifier in response to receiving a search request comprising search criteria from that user. The only indication of any kind of reference to an organization lies in the statement regarding generation of reports that can be performed by a variety of parameters. However, there is no suggestion in this section that these parameters are determined in response to receiving a search request or are any way related to the person who submits search criteria.

The Office Action also references a section of Green that provides: “For security purposes, access to documents may be limited or based on personnel status.” *See* Green 3:49-52. Applicants submit that the Office Action provides no indication as to why “personnel status” corresponds to an organizational identifier as disclosed by the present invention or claimed. And again, there is no suggestion in the cited section that there is a determination of “personnel status” made in response to receiving a search request, as required.

The Office Action also cites to Green 4:6-25 as purportedly providing disclosure of the “determining” limitation. As an initial matter, Applicants respectfully submit that the Office Action provides no indication of what disclosure within the 20 lines of text actually corresponds to the “determining” limitation, as required (*see* 37 CFR § 1.104(c)(2)). In addition, Applicants respectfully submit that there is no disclosure within the cited text of an organizational identifier or of “determining” an organizational identifier in response to receiving a search request. Green discloses “means ... for identifying users qualified to access the database.” *See* Green 4:16-17. Applicants respectfully submit that the term “qualified to access the database” does not provide disclosure of the claim limitation, which requires determining an organizational identifier. There is no indication in the cited section of what is meant by a user being “qualified to access the database.”

The Office Action then cites to a section of text in Green that is unrelated to receiving a search or performing a search of a database. *See* Office Action, p.4 (citing Green 6:3-22). This section of Green relates to the illustration of Figure 1, which is disclosed to be purportedly related to “loading certain information obtained from the

institution into the database.” *See* Green, 5:54-56. Templates are purportedly provided to allow definition of document categories and document attributes for each document being added to the database. *See* Green 5:62-6:2. User attributes are added to the system during set up. *See* Green 6:3-5. Rules are also provided for purportedly “linking or matching documents with users,” wherein “[e]ach rule defines a relationship between a set of users and a set of documents.” *See* Green 6:5-10. Thus, there is no disclosure in the cited section of determining a user’s organizational identifier in response to receiving a search request. In fact, this section relates entirely to configuring a data structure purportedly disclosed by Figure 1 of Green. *See also* Green 6:19-21 (“All of this data is stored in the database. This data defines the institution’s data structure. It makes it possible for the system to find, organize and display data quickly and easily.”).

The Office Action also cites to Green 9:49-10:6 as purportedly providing disclosure of the “determining” limitation. Again, this section appears to suggest that the system determines if the user is an administrator. But such a determination of whether the user is an administrator, has no relationship to the sections cited in the rest of the document, nor does it have any relationship to receiving a search request or whether the user’s organizational identifier would be determined in response to receiving a search request.

For at least the above reasons, Applicants respectfully submit that the cited sections of Green fail to provide any disclosure of the “determining” limitation.

Applicants also respectfully submit that the sections of Green cited by the Office Action fail to provide disclosure of the “performing” limitation provided by the independent claims. As purported disclosure of the “performing” limitation, the Office

Action cites to a section of Green related to purportedly using links between documents and users that are set up during the pre-publication process disclosed in Green. *See* Office Action, p.5 (citing Green 7:8-13). Green provides for a pre-publication process that allows for (1) including user data into the system (Green 7:19-27), (2) determining whether a new document is either redundant, contradictory, or obsolete through the use of a comparison search with other documents (Green 7:33-65), (3) whether to include a test related to the document (Green 8:3-17), (4) a quality review (Green 8:18-33), (5) obtaining approvals for the documents to be added (Green 8:34-52), and (6) creating “user to document” links (Green 8:53-9:7).

The disclosed pre-publication process provides that a determination is made as to those users who can access a particular document before any search for a document is received from a user. *See also* Green 7:3-7 (“As a final step before the document is published, the linking process, illustrated in Fig. 8, is performed to create links between the document and all of the users who are responsible for complying with the policy set forth in the document.”). Green provides for generating a list of users having a particular attribute value and creating a link between a document and those user. *See* Green 8:53-9:7 (“Links are created between each of the documents in the document list and each of the users in the user list. Each of the links created is stored in the database.”). Therefore, Green is not designed to perform the claimed “performing” limitation, which requires “selecting an organizational set of records that match the first user’s organizational identifier from the one or more databases, and selecting a subset of records matching the search category from the organizational set of records,” in response to receiving a search request. None of the sections of Green cited by the Office Action contradict or provide an alternate mechanism to that disclosed in the above discussed sections of Green. *See*

Green 7:8-13 (discussing the use of the “user to document” links), and Green 4:48-63 (also apparently related to Green’s disclosed “user to document” links).

For at least the above reasons, Applicants respectfully submit that Green fails to provide any disclosure of the “performing” limitation provided by the amended claims.

The Office Action admits that Green does not provide disclosure of “performing a search in one or more databases based on the search criteria and the first user’s organizational identifier” (Office Action, p. 5), a proposition with which Applicants agree. The Office Action suggests that Byrne provides the missing disclosure from Green related to performing the search based on “the first user’s organizational identifier.” The Office Action cites to sections of Byrne that relate to a “Lightweight Directory Access Protocol” (LDAP) that purportedly allows for one to locate a server in a distributed network by “maintaining information for the server, displaying a tree of servers, browsing the tree of servers, and searching the tree of servers for an entry with specific attributes.” *See* Byrne, Abstract. The cited sections further provide that “[t]he search can be based on one of the following attributes: user, country, group, locality, access group, access role, organization, organization unit, domain, or can be based on user defined attributes.” *Id.*

Applicants respectfully submit that the cited sections of Byrne merely disclose performing an LDAP search using an attribute such as those listed. There is no disclosure of any of these attributes being a determined user organization identifier as provided in the claims. These attributes are disclosed to actually be provided by the user and are not determined from information about the user. *See* Byrne 7:37-52 (disclosing a purported mechanism for a user to provide input for a search). Even were the Office

Action's indication that a "administrative user" in some way relates to the "determining" limitation, there is no connection made in either the references or the Office Action between the "administrative user" and any disclosure in the cited sections of Byrne. Applicants therefore respectfully submit that Byrne fails to provide the admittedly missing disclosure of Green.

The Office Action further admits that the combination of Green and Byrne fail to "explicitly indicate wherein performing the search includes restricting the scope of search based on the first user's organizational identifier, which further includes selecting a subset of data records that match the first user's organizational identifier from a set of records that are associated with the at least one search category," a proposition with which Applicants agree. *See* Office Action, p. 6. The Office Action then cites to sections of Mayaud as providing purported disclosure of these claim limitations. Applicants respectfully submit that the amendments made to the independent claims renders this rejection moot. Applicants further respectfully submit that the amendments made to these claims' limitations have been made for purposes of clarification and should not be construed as an admission that Mayaud provides disclosure of any invention now or previously claimed.

For the reasons presented above, Applicants respectfully submit that the Office Action does not establish the presence of the above limitations in Green, Byrne or Mayaud, alone or in combination. The burden is on the Examiner to support a case of obviousness, including whether the prior art references teach or suggest all of the claim limitations. *See* MPEP 706.02(j).

In addition, Applicants also respectfully submit that the Office Action has not satisfied the burden of factually supporting the alleged motivation to combine the three references. This duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Office Action must therefore provide evidence to suggest the combination and “[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Further, the Office Action fails to establish that such a combination of the teachings of these references would meet with success, as required.

The Office Action intimates that there is an “intended broad application of the Green system,” and therefore it would be obvious to modify the teachings of Green with those of Byrne. *See* Office Action, p. 5. Applicants respectfully submit that the disclosure of Green actually provides a fairly narrow application of the disclosed system and that narrow application is intended to be directed toward “health care policy on-line maintenance dissemination and compliance.” *See* Green, Title. In fact, the claims of Green are directed toward a “health care policy document storage and contents comprehension testing system,” and include “means for storing the contents of a plurality of health care policy documents in a database.” *See* Green, Claim 1 (emphasis added).

There is no indication within Green that there would be any advantage to including the Lightweight Directory Access Protocol described in Byrne in the disclosure of Green. Byrne’s LDAP is purportedly a “software protocol for providing directory service enablement to a large number of applications” ranging from “e-mail to distributed

system management tools.” See Byrne 1:38-46. There is no indication in Green that such a distributed directory service would be useful.

Applicants further submit that inclusion of the “prescription management system” of Mayaud is also not indicated by either the disclosure of Green or the disclosure of Byrne. Green is purportedly related to distribution of documents to users within a health care system. Mayaud is purportedly related to “a wirelessly deployable, electronic prescription creation system.” See Mayaud, Abstract. There is no indication in either Green, Byrne or Mayaud for how such a prescription system could be incorporated into the disclosure of Green, nor does the Office Action provide any. Therefore, Applicants respectfully submit that the Office Action fails to establish a motivation to combine the references.

The Office Action makes no showing of a motivation to combine Green with either Byrne or Mayaud from within the references themselves; therefore, it must be presumed that there is none. It is well-established that the best defense to hindsight is a “rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” See *Ecolchem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000); *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000). A showing of combinability must be “clear and particular” and “broad conclusive statements about the teaching of multiple references, standing alone, are not ‘evidence.’” See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson*, 229 F.3d at 1125.

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the

field; or 3) from the nature of the problem to be solved, "leading inventors to look to references relating to possible solutions to that problem."

Ruiz, 234 F.3d at 665.

The Office Action presents nothing more than broad, generalized statements related to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not establish that the references which are combined are of special interest or importance in the field of the invention. Indeed, Green is in the separate and distinct field of providing health care policy on-line, rather than the field of Byrne, which is for accessing information in a distributed system through a Lightweight Directory Access Protocol. Nor does the Office Action present any evidence of a problem to be solved within those references themselves.¹ Instead, the Office Action fabricates such a problem to be solved, not from the teachings of the cited references, but from the teachings of Applicant's own disclosure, which is expressly impermissible. See *W. L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552-53 (Fed. Cir. 1983).

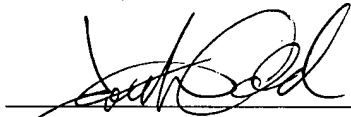
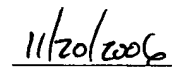
Further, the Office Action provides no indication of why a person of ordinary skill in the art would expect that the combination of Green with Byrne and Mayaud would successfully result in the claimed invention. For reasons discussed above, Applicants respectfully submit that the dramatically different fields encompassed by Green and Byrne would lead one to the opposite conclusion, that is, that such a combination would not be successful.

¹ There must be a finding that "there was a disadvantage to the prior systems, such that the 'nature of the problem' will have motivated a person of ordinary skill to combine the prior art references." *Ruiz*, 234 F.3d at 666.

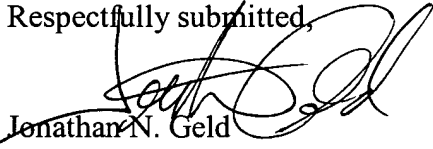
For at least these reasons, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of independent Claims 1, 24, 47, 56 and 72, as amended, and all claims depending therefrom, and that they are in condition for allowance. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections as to those claims, and an indication of the allowability of same.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, COMMISSIONER FOR PATENTS, P. O. Box 1450, Alexandria, VA 22313-1450, on November 20, 2006.	
	
Attorney for Applicant(s)	Date of Signature

Respectfully submitted,


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